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**JUN 24 2003**

In re Application of  
Victor J. Dzau et al  
Application No. 09/839,752  
Filed: April 19, 2001  
Attorney Docket No. 50025/003002

**OFFICE OF PETITIONS  
ON PETITION**

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 28, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of two prior-filed nonprovisional applications.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed nonprovisional applications.

The instant pending nonprovisional application was filed on April 19, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed nonprovisional applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2). However, on the other hand, if the USPTO does not note the claim for priority to the nonprovisional application in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3).<sup>1</sup> In the instant case, the Office noted the claim for priority of the nonprovisional applications in the transmittal letter filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the \$1,300 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application,

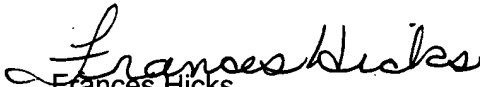
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<sup>1</sup> Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001, and MPEP 201.11 at page 200-75.

the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

Any questions concerning this decision on petition may be directed to Karen Creasy at (703)305-8859. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center AU 1636 for processing the amendment embodied in the petition of May 28, 2003, and for consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) for the benefit of the prior-filed nonprovisional applications.

  
Frances Hicks  
Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

cc:

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